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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,052	05/14/2001	Uttandaraman Sundararaj	08CU-5777	8668

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,052

Applicant(s)

SUNDARARAJ ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 56 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 32, 33, 11 to 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 9, 12 to 31, 34 to 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1712

1. Applicant's election of the polycarbonate ester species in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 9, 12 to 31, 34 to 43 and 46 to 50 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 921 161, herein Puyenbroek et al.

Puyenbroek et al. teach thermoplastic compositions containing a polyetherimide component (meeting the limitation of component (a) and the specific limitations of claims 2 to 6), a polycarbonate and a polysiloxane (meeting claimed component (c)). This differs from that claimed in that Puyenbroek et al. do not specifically show an example using a polycarbonate ester, applicants' elected component (b).

However, as can be seen from the teachings of operable polycarbonate on page 6, carbonate esters can be used. See for instance lines 43 to 45. Thus Puyenbroek et al. suggest using polycarbonate esters and the polycarbonate component and as such one having ordinary skill in the art would have found the claimed combination of components obvious. Note that the bottom of page 7 teaches various additives as found in claim 21. This composition is used to form a molded article of manufacture. Regarding

main view

Art Unit: 1712

the limitation of, for instance, claim 12, note that the siloxane on page 7 meets this formula. While the molecular weight range claimed is not specifically taught, page 7, line 10, teaches that the siloxane can have a weight average molecular weight of greater than about 1,500 g/mole, embracing the claimed range.

5. Claims 1 to 9, 21 to 31 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 704 487.

The Examiner notes that EP 704 487 anticipates these claims because the term "a polydiorganosiloxane" is inclusive of polydiorganosiloxane copolymers.

EP 704 487 teaches polyester-carbonate blends. This polyester-carbonate meets applicants' elected component (b). Blended with the polyester-carbonate is a polyether-imide (meeting claimed component (a)) and a polysiloxane-polyetherimide copolymer. See the bottom of page 2 through page 3. This anticipates the instant claims. Page 7 teaches the presence of various additives meeting claim 21. These blends are used to form molding compositions.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 921 161.

While 921 161 does not teach these specific method steps, adjusting the order of addition for the components in EP 921 161 would appear to have been well within routine experimentation and/or optimization for one having ordinary skill in the art. Thus, first mixing the polydiorganosiloxane with the polyimide or polycarbonate, or mixing the polydiorganosiloxane with the inorganic particles, prior to mixing all of the components would appear to have been an obvious difference over the teachings of EP 921 161.

Art Unit: 1712

8. The remaining references are cited as being of general interest. Puyenbroek et al. is the US equivalent of EP 921 161. Romenesko et al. teaches a method for imparting flame retardancy to organic resins such as polycarbonates and polyimides. This reference first disperses the polydiorganosiloxane with a silica filler, supporting the Examiner's position that the method steps of claim 45 would have been obvious to one having ordinary skill in the art since this initial step is known in the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
January 29, 2003